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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/872,353	06/01/2001	Brian R. McCarthy	67134-5038	3630

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EXAMINER

CHEVALIER, ALICIA ANN

ART UNIT PAPER NUMBER

1772

DATE MAILED: 12/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/872,353

Applicant(s)

MCCARTHY ET AL.

Examiner

Alicia Chevalier

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 314-409 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 314-409 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

RESPONSE TO AMENDMENT

1. Claims 314-409 are pending in the application, claims 1-313 have been cancelled.

REJECTIONS

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 314-409 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In the instant case amended claims 314, 339, 363 and 387 contain(s) the limitation "the ultraremovable adhesive ... the back surfaces being non-tacky and the exposed portion of the liner sheet being tacky." The examiner is unable to find support for the limitation in the specification, therefore this limitation is considered new matter.

The specification on pages 8-9, paragraph [0023] recites;

The ultraremovable adhesive is peeled off with the paper waste strips and the cover strips thereby providing a clean back side to the cardstock sheet (and thereby the

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printed media). The clean back sides) (even when a coating thereon is provided) advantageously can be written on, that is, it accepts pencil, ink and even inkjet and laser printing. *The ultraremovable adhesive sticks to the paper allowing for easy removal and disposal of the paper strips, and even though it is tacky it does not stick to anything permanently.* In contrast, the "Paper Direct" product uses a removable adhesive. (Generally, adhesions of "ultraremovable To assist the sheet in being fed into the printer or copier the lead-in edge thereof is preferably calendered, unlike the "Paper Direct" product. The web, before sheeting, is preferably calendered with textured calendering dies before the face cutting station. The calendering step is also preferably performed after the printing operation on the web wherein identifying and explanatory information is printed on the cardstock." adhesives at their highest adhesion levels (to a surface such as stainless steel) are roughly half of what they are for conventional "removable" adhesive. A fundamental difference is that conventional adhesives provide complete contact with a substrate while ultraremovable adhesive provide partial contact. This limited contact area is what prevents an ultraremovable adhesive from becoming permanent, over time.)

This is the only that discuss the "tackiness" of the adhesive and it state that the adhesive is completely tacky not just partially. The new matter must be deleted.

ANSWERS TO APPLICANT'S ARGUMENTS

5. Applicant's arguments in the response filed September 14, 2006 regarding the 35 U.S.C. 112-1st paragraph of record have been carefully considered but are deemed unpersuasive.

Applicant contends that the Declaration by Ronald Ugolick, Ph.D., filed September 14, 2006, proves that the written description requirement was met and no new matter was introduced.

Dr. Ugolick states that it is known to those skilled in the art, a removable adhesive is characterized by clean removability from a first surface with the sticky pressure-sensitive adhesive (psa) remaining on the opposing surface. This statement is somewhat unclear, but the examiner interprets this statement to mean that the adhesive remains on the release liner and not

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the stock material. The examiner generally agrees that this a broad definition of an “ultraremovable adhesive.”

Dr. Ugolick also states that an ultraremovable adhesive, as explained in the subject application as well as in the article “Analytical Methods Optimize Ultraremovables” (Ingrid Brase, et al., Coverting Magazine, December 200), cited earlier in the prosecution of the application, is a removable adhesive that does not become permanent over time.

The examiner is unable to find support for or what is meant “become permanent over time” in the specification or in the article. Also, the examiner has already considered the article “Analytical Methods Optimize Ultraremovables” to be unpersuasive to help define what an “ultraremovable adhesive.” As stated in the interview summary from April 20, 2005: Applicant’s evidence, the Article from Coverting Magazine December 2000, merely states “ultraremovable pressure sensitive adhesive *can be* defined as products which do not build or gain peel adhesion over time and are cleanly removable from the substrate.” The article clearly implies that ultraremovable adhesives can have other definitions than the one set forth in the article.

Dr. Ugolick also states that an example of an ultraremovable adhesive is that used in 3M’s POST-IT notes. After removing one of these notes from a pad of same, applying the note (adhesive strip side down) to a surface and then later peeling the note off of the surface, the surface is left non-tacky, while the adhesive strip portion of the note remains tacky.

While 3M’s POST-IT notes maybe an example of a type of ultraremovable adhesive it, is unclear how it is evidence that the specification has support for the limitation “the ultraremovable adhesive ... the back surfaces being non-tacky and the exposed portion of the

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liner sheet being tacky.” Actually appears to help support the examiner’s position that the back surface of the adhesive is still tacky since POST-IT notes can be removably adhered to different surfaces. While the adhesive may not permanently stick to the first surface it is adhered to, the adhesive remains tacky enough to stick to a second surface or more.

Dr. Ugolick further states thus, an ultraremovable adhesive as would be known to those skilled in the art from the present application allows the printed business cards to be removed from the liner sheet with the back side surface of the business cards being non-tacky and the exposed portion of the liner sheet being tacky.

While the examiner generally agrees with this statement, she does not believe this is what claim 314 is stating. The claim recites “the ultraremovable adhesive ... the back surfaces being non-tacky and the exposed portion of the liner sheet being tacky.” As the examiner has stated before, the only discussion with regard to the “adhesive” that it is tacky. There is no support in the specification for the “adhesive” to have a back surface being non-tacky and the exposed portion of the liner sheet being tacky. The only support in the specification for the adhesive is that it is completely tacky.

Therefore, the examiner finds the Declaration by Ronald Ugolick, Ph.D. to be unpersuasive and maintains the rejections of record.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (571) 272-1490. The examiner can normally be reached on Monday through Friday from 8:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ac
11/26/06



ALICIA CHEVALIER
PRIMARY EXAMINER